

Remarks

I. Restriction of Groups I and II

The Restriction Requirement contends that the claims as filed are directed to the following distinct inventions: (1) Group I (claims 1-39) and (2) Group II (claims 40-43).

Applicants elect, with traverse, Group I, claims 1-39 for prosecution in the present application. Applicants also request rejoinder of the claims of Group II with the Group I claims for prosecution in the present application.

A restriction under MPEP § 806.05(e) requires a showing that the process as claimed can be practiced by *another and materially different* apparatus or by hand or the apparatus as claimed can be used to practice *another and materially different* process. MPEP § 806.05(e) further states that the burden is on the Examiner to provide *reasonable* examples that recite material differences. The action contends that restriction in this case is proper because the process as claimed can be used to make “another and materially different product such as forming metal cans or drums where the particulars of the method are not required in the article claims.”

In reply, Applicants submit that the action has not presented any reasonable examples in entering the restriction requirement. Independent claim 40 (Group II) recites a method of manufacturing a flexible pipe comprising disposing a flexible metallic ply having a circular cross section in an outer tubular layer, and folding over approximately one half of the circular cross section of the ply over its other half portion to form a substantially arcuate configuration having enlarged side portions. In contrast, metal cans and drums are rigid structures and do not contain a flexible metallic ply disposed in an outer tubular layer, as required in claim 40. Moreover, metal cans and drums have a bottom wall at one end to contain material placed therein and a removable lid to access and remove the material. The claimed method does not provide for a bottom wall or a removable lid. Hence, the instantly claimed method of manufacturing a flexible pipe clearly cannot be used to manufacture metal cans and drums. Accordingly, the PTO’s burden under MPEP § 806.05(e) of presenting a *reasonable* example of another and materially different product that actually can be made from the instantly claimed process has not been satisfied.

Further, MPEP § 803 states that “If a search and examination of an entire application can be made without serious burden, the Examiner must examine [the entire application] on the

merits, even though it includes claims to independent or distinct inventions.” Since the inclusion of all claims in the present application would not impose any serious burden on the Examiner, MPEP § 803 requires that the restriction be withdrawn so that all pending claims can be examined in the present application.

II. Restriction of Species

The Restriction Requirement also contends that the application includes the following distinct species: FIG. 1, FIG. 3, FIG. 5, FIG. 7, FIG. 9 and FIG. 11.

Applicants elect, with traverse, the claims corresponding to FIG. 9. At least claims 1-5, 9-17, and 24-30 are readable on this species.

Applicants are unable to discern how searching the claims to each species would impose a *serious burden* on the Examiner. Thus, as provided in MPEP § 803, the restriction of the identified species should be withdrawn.

III. Conclusion

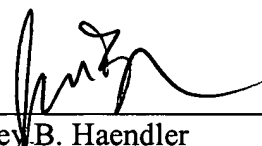
For the foregoing reasons, Applicants request that the Restriction Requirement be withdrawn and all pending claims examined. In making the above remarks, Applicants do not admit that any of the independent claims are obvious in light of one another.

The Examiner is invited to call the undersigned if there are any issues remaining concerning this matter.

Respectfully submitted,

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